



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,992	12/12/2000	Anuj Jain	ERIC P12549	3370

7590 12/02/2003

DAVID E. BENNETT
COATS & BENNETT P.L.L.C.
1400 CRESCENT GREEN
SUITE 300
CARY, NC 27511

EXAMINER

NAJJAR, SALEH

ART UNIT	PAPER NUMBER
----------	--------------

2157

DATE MAILED: 12/02/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,992

Applicant(s)

JAIN, ANUJ

Examiner

Saleh Najjar

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-32, 35-48 and 51-68 is/are rejected.
- 7) ☒ Claim(s) 33, 34, 49 and 50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

Art Unit: 2157

1. This action is responsive to the amendment filed on September 11, 2003. Claims 1-25 were canceled. Claims 26-68 are newly added. Claims 26-68 are pending. Claims 26-68 represent a method, system and product for controlling inclusion of email content.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26-32, 36-40, 42-48, 52-56, 57-61, and 63-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogilvie et al., U.S. Patent No. 6,487,586.

Ogilvie teaches the invention as claimed including a self-removing email, verified or designated as such by a message distributor for the convenience of a recipient (see abstract).

As to claim 26, Ogilvie teaches a method of controlling retransmission of email message content in an email message by a recipient of the email message, the method comprising:

inserting control information into a first email message to control retransmission of the email message content in a second email message originating from a recipient of the first email message; and transmitting the first email message to the recipient (see fig. 2; col. 5, Ogilvie discloses that a removal code, 208, and 210 facilitate removal of some or all portions of a message sent and retransmitted by the receiver in either a reply or forward email function).

As to claim 27, Ogilvie teaches the method of claim method of claim 26, wherein the second email message comprises a reply message, and wherein the control information controls inclusion of the email message content in the reply message (see col. 6, lines 5-15, Ogilvie discloses that the control information controls the inclusion of email content in a reply message).

As to claim 28, Ogilvie teaches the method of claim 26, wherein the second email message comprises a forwarding message, and wherein the control information controls inclusion of the selected portions of the email message content in the forwarding message (see col. 5-6).

As to claims 29-30, Ogilvie teaches the method of claim 26, wherein the control information causes at least a portion or the entire of the email message content to be excluded from the second email message (see col. 5, line 33, Ogilvie discloses that the control code can specify portion of or all of the message content to be deleted).

As to claim 31, ,Ogilvie teaches the method of claim 26, further comprising selecting a portion of the email message content to be excluded from the second email message, and wherein the control information causes the selected email message content in the first email message to be excluded from the second email message (see col. 5-6).

As to claim 32, Ogilvie teaches the method of claim 31, wherein selecting a portion of the email message content to be excluded from the second email message comprises receiving a keyword entered by a user and selecting portions of the email

message content based on the keyword entered by the user (see col. 5, line 31; col. 9, lines 1-3; col. 13, Ogilvie discloses that keyword data in the message information can also be used to control the content deletion of portions or all the message).

Claims 36-40, 42-48, 52-56, 57-61, 63-67 do not teach or define any new limitation above claims 26-32 and therefore are rejected for similar reasons.

5. Claims 35, 41, 51, 62, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie further in view of Foldare et al., U.S. Patent No. 6,311,210.

Ogilvie teaches the invention substantially as claimed including a self-removing email, verified or designated as such by a message distributor for the convenience of a recipient (see abstract).

As to claim 35, Ogilvie teaches the method of claim 26.

Ogilvie does not explicitly teach the limitation wherein the control information causes at least a portion of the email message content to be excluded from the second email message based on the identity of the recipient.

However, Foldare teaches a method and system for determining the portions of email content to send to receiving devices based on identity of the receiving devices (see abstract). Foldare teaches causing at least a portion of the email message content to be excluded from the second email message based on the identity of the recipient (see col. 3, Foldare discloses that some portion of the email content may be embodied in the case of a PDA receiver).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ogilvie in view of Foldare so that email content delivered is based on the receiver's identity. One would be motivated to do so to accommodate the receiving capability of different devices used to receive electronic mail.

Claims 41, 51, 62, and 68 do not teach or define any new limitations above claim 35 and therefore are rejected for similar reasons.

6. Claims 33-34, and 49-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Applicant's arguments filed September 11, 2003 have been fully considered but they are not persuasive.

In the remarks, the applicant argues in substance that Ogilvie fails to teach "inserting control information into a first email message to control retransmission of the email message in a second email message originated from the recipient of the first email message".

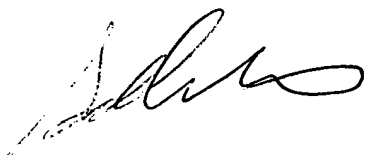
In response, Ogilvie does teach and reads on all aspects of the independent claims by disclosing inserting control code 208, and 210 into the email message to control the retransmission of the portions or all of the email content through a reply or forward message function at the receiver(see col. 5-6).

Art Unit: 2157

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saleh Najjar whose telephone number is (703) 308-7613. The examiner can normally be reached on Monday-Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ario Etienne*, can be reached on (703) 308-7562. The fax phone number for this Group is (703) 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600. The fax number for the After-Final correspondence/amendment is (703) 746-7238. The fax number for official correspondence/amendment is (703) 746-7239. The fax number for Non-official draft correspondence/amendment is (703) 746-7240.



Saleh Najjar

Primary Examiner / Art Unit 2157